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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

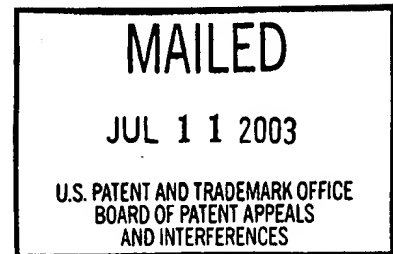
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUHIKO AOKI, MAKIO TSUCHIYA, and SEIYA INOUE

Appeal No. 2001-2022
Application No. 09/112,020¹

ON BRIEF



Before BARRETT, FLEMING, and DIXON, **Administrative Patent Judges.**
DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19-26.

Claims 1-18 have been indicated as allowed by the examiner.

We **AFFIRM** and enter a rejection under 37 CFR 1.196(b).

¹This application is a reissue application, filed on Jul. 8, 1998, of US Patent 5,535,430, which issued on Jul. 9, 1996, from Application 08/208,707, filed Mar. 11, 1994.

BACKGROUND

Appellants' invention relates to mobile communication terminal equipment usable for both satellite and terrestrial communications. An understanding of the invention can be derived from a reading of exemplary claim 19, which is reproduced below.

19. A mobile communication terminal equipment comprising:

- a satellite transceiver including a satellite transmission/reception circuit for transmitting and receiving signals through a satellite wireless communication system; and

- a portable set disconnectable from the satellite transceiver and including

- a terrestrial transmission/reception circuit for transmitting and receiving signals through a terrestrial wireless communication system,

- a signal input/output circuit for inputting signals from the user and for outputting signals to the user, and

- a connection controller and switching means for selectively connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transmission/reception circuits when said portable set is connected to said satellite transceiver and for connecting said signal input/output circuit to said terrestrial transmission/reception circuit when said portable set is disconnected from said satellite transceiver.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Wiedeman	5,303,286	Apr. 12, 1994 (filed Mar. 29, 1991)
Murata	JP-4-123534 (Japanese Kokai Patent Publication)	Apr. 23, 1992

Claims 19-26 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the (original) application (for patent) was filed, had possession of the claimed invention. Claims 19-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiedeman in view of Murata.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Nov. 2, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 10, filed Aug. 8, 2000) and reply brief (Paper No. 12, filed Jan. 2, 2001) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 USC § 112, FIRST PARAGRAPH

The examiner maintains that the specification has defined the mobile communication terminal equipment as being mounted in a vehicle and that the deletion of the limitation concerning being "mounted" makes the entire terminal portable including the satellite transceiver. The examiner maintains that such a feature is not supported by the original specification and therefore appellants lacked possession of this invention at the time of filing. (See answer at pages 3-4.)

Appellants argue that the language of claims 19-26 does not recite that the satellite transceiver is portable, but rather do not require it to be mounted or mountable. (See brief at page 6.) We agree with appellants that the deletion of the "mountable" limitation, does not require that the satellite transceiver be portable. Appellants argue that the specification states that the satellite transceiver is "mountable" in the vehicle and the transceiver unit may be "disposed within the interior" of a vehicle. (See brief at page 7.) We find that the disclosure as a whole does not require that the satellite transceiver be mounted in a vehicle, but rather that it may be placed/disposed in a vehicle for use therein during movement or travel of the user. Therefore, we find that appellants were in possession of the invention as recited in independent claim 19 and we will not sustain the rejection thereof under 35 USC § 112, paragraph 1.

35 USC § 103

To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.

In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we agree with the examiner's rejection and find that appellants have not shown error in the rejection. Therefore, we find that appellants have not overcome the rejection by showing insufficient evidence of *prima facie* obviousness nor have appellants submitted any evidence of secondary considerations.

Since appellants have indicated that all the claims stand or fall together in a single group, we will select independent claim 19 and address appellants' argument with respect to this claim. (See brief at page 5.) At the outset, we note that the examiner has addressed the limitations of independent claim 19 identifying what is taught expressly by Wiedeman and what is not expressly taught and provides a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art to have modified the teachings of Wiedeman with the teachings of Murata. (See

answer at pages 5-6 and 9-10.) We agree with the examiner and find that the examiner has set forth a ***prima facie*** case of obviousness. Therefore, the burden shifts to appellants to rebut this ***prima facie*** case of obviousness. Therefore, we find that the examiner has established a ***prima facie*** case of obviousness of the claimed invention and appellants have not shown error therein or adequately rebutted this ***prima facie*** case. Therefore, we will sustain the rejection of independent claim 1 and all the claims grouped therewith.

The examiner maintains that Wiedeman teaches a combination of both terrestrial and satellite transceivers for receiving and transmitting in each of the modalities and that Wiedeman teaches the use of an input/output device and switching means for selectively connecting the input/output device to one of the satellite or terrestrial transceivers, but does not disclose that the two transceivers are disconnectable and relies on the teachings of Murata to teach this aspect of the claimed invention. We agree with the examiner's analysis of the prior art references. In addition, we find that Murata also discloses the use of both satellite and terrestrial transceivers in a single unit in figure 3 and in an embodiment in figure 5 where the two transceivers are disconnectable. Figure 3 of Murata teaches that there is also a switch and controller for connecting the telephone handset (input/output device) to either of the satellite or terrestrial transceivers. (See Murata's translation at page 5, line 29 -page 6, line 4.)

In figure 3, the two transceivers are separate units with a separate switch and controller unit 80 connected to both transceivers to connect the telephone input/output device to the transceiver. In figure 5 the separate switch and controller unit is integrated into the satellite transceiver without stating any reasoning why it is integrated with the satellite transceiver rather than the terrestrial transceiver. (See Murata's translation at page 7, lines 3-8.) Murata discloses that the combination of the mobile systems would permit registration and connection among wireless transmission type mobile communication systems having any frequency band and modem systems different from one another. (See Murata's translation at page 4 lines 1-9.) From our review of the disclosure of Murata, we conclude that it would have been an obvious matter of design choice to one of ordinary skill in the art integrate the switch and controller, which interface with the telephone handset and ten key input, into the terrestrial transceiver rather than the satellite transceiver. Murata discloses that the telephone set can be connected to each piece of mobile equipment to act as a dedicated mobile system and that it is the unifying and combining of the elements which ensures compatibility without any statement of criticality to the integration into the satellite transceiver. (See Murata's translation at page 7, line 30 - page 8, line 7 and see also page 6, line 30 - page 7, line 2.). With this integration, the switch and controller would have still interconnected the input/output device to either of the

transceivers when connected together and when disconnected from each other, the switch and controller would have connected the input/output device to the terrestrial transceiver as recited in independent claim 19. Since appellants have elected to group all the claims as standing or falling together, we will sustain the rejection of claims 20-26 with representative claim 19.

Appellants argue that the portion of Murata relied upon by the examiner to teach that separate transceivers could be interchanged is simply an introductory paragraph for the description of figure 5 and that the description of figure 5 teaches that the switch is provided on the satellite side. (See brief at page 10 and reply brief at page 3.) We agree with appellants that the specific teaching of figure 5 states that the switch and controller of figure 3 are integrated into the satellite side, but we do not agree with appellants that this **REQUIRES** that it be on the satellite side. Murata does not provide any rationale why one transceiver is more desirable than the other to be integrated. Therefore, we agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to integrate the switch and controller into either of the transceivers per the desires of the end user of the communication terminal. Therefore, this argument is not persuasive. Throughout appellants' arguments we find repeated references to reduction in size, but we find

neither explicit nor implicit claim limitations thereto. Therefore, this argument is not persuasive.

Appellants argue that the system of Wiedeman would be destroyed or would eliminate the fundamental functionality or purpose of the Wiedeman if it were combined with Murata. (See brief at page 12.) We disagree with appellants since Murata teaches that compatibility between various mobile units is the desired result. Similarly, it would have been desirable to have the satellite transceiver and terrestrial receiver of Wiedeman to be compatible with other units as taught and fairly suggested by Murata. Therefore, this argument is not persuasive. Therefore, we do not find that appellants have rebutted the *prima facie* case of obvious established by the examiner, and we will sustain the examiner rejection under 35 USC § 103(a).

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiedeman in view of Murata. We limit our application of the prior art to independent claim 1 and leave the evaluation of the dependent claims to the examiner upon return of the application to the examiner. We reject claim 1 under the same ground of rejection over Wiedeman in combination with Murata as set forth by the examiner as embellished above in our discussion. From our understanding of the broadening of claim 1 to set forth new claim 19, we find that it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have made the combined terrestrial and satellite transceiver system "mountable in a vehicle" and made the terrestrial or portable transceiver able to be carried by a user as recited in independent claim 1 and clearly taught as suggested by the teachings of Murata. We deem it readily apparent to those skilled in the art of telecommunications that any terrestrial transceiver or satellite transceiver could be mounted or mountable in a vehicle in a manner so as to fix or fasten the phone therein. We find it so apparent to skilled artisans as to take "**OFFICIAL NOTICE**" thereof. Additionally, as evidence thereof, Wiedeman discloses in figures 1-3 a representative end user 30 which is shown as a vehicle. Similarly, the use of the terminology in Murata of "mobile" units/equipment implies that the units are transported by either a vehicle or a user. From our interpretation of the limitations of independent claim 1, we find no limitations on the means or manner of mounting or disconnectability therein. Therefore, we find that the teachings of Wiedeman and Murata clearly teach and fairly suggest this aspect of the claimed invention.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

CONCLUSION

To summarize, the decision of the examiner to reject claims 19-26 under 35 U.S.C. § 112, first paragraph is reversed, and the decision of the examiner to reject claims 19-26 under 35 U.S.C. § 103(a) is affirmed, and we enter new grounds of rejection of claim 1 under 35 U.S.C. § 103(a).


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED - 37 CFR 1.196(b)


LEE E. BARRETT
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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